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US PATENT DIVISION

513 627 6883 P.04/05

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2003.

Inventor's Name

Name

Signature

John M. Carr

Case 8083

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of :
Hirofaka Uchiyama, et al. :
Serial No. 09/855,816 : Group Art Unit 1751
Filed: May 15, 2001 : Examiner J. Hardee
Confirmation No. 9687 :

For :
COMPOSITIONS COMPRISING
CYCLODEXTRIN

#5
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TC 1700

RESPONSE

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is responsive to the Office Action mailed March 31, 2003 (Paper No. 3).

Claims 1-59 are pending, and are subject to a requirement for the election of species. The Examiner has requested that the Applicant elect a single disclosed species as in an example. The Office Action indicates that one method commensurate in scope with the species will be examined.

The applicants hereby respectfully traverse the requirement for the election of species. The election of species is governed by 37 C.F.R. § 1.141(a). Section 1.141(a) of Title 37 of the Code of Federal Regulations provides:

- (a) Two or more independent and distinct inventions may not be claimed in one national application, except more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims of a national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§1.75) or otherwise include all the limitations of the generic claim. (Emphasis added).


Applying the test set out in the regulations, if the Applicants elect a "species" that is covered by an independent claim (such as Claim 1, for instance), the Applicants should be permitted to prosecute all of the claims that are dependent from that claim. The Applicants should not then also be subjected to further requirements for the election of species in a single example.

For the purpose of complying with 35 U.S.C. Section §121, however, and without admitting that the requirement for the election of species is proper, the Applicants elect to prosecute the species of Example IV. However, the Applicants do not wish to be limited ~~the compositions that comprise cyclodextrin-incompatible materials in the form of odor~~ blockers. The claims that cover this species include Claims 1, 9, 12, 14, 18, 23, 26, 29, 34, 42, and 43. The Applicants submit that the method claims commensurate in scope with this species include Claims 55-59, since these are dependent from Claim 1.

The Applicants submit that under 35 U.S.C. Section §121, they should be permitted to prosecute Claim 1, and all of its dependent claims, or Claims 1-51 and 55-59.

Further, since Claim 1 is generic, if Claim 1 is allowed, the Applicants believe that Claim 1 will cover all of the species that it could read on, even though Applicants were required to elect only a single species herein.

Respectfully submitted,
HIROTAKE UCHIYAMA, ET AL.

By 
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June 30, 2003
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FROM: Jeffrey V. Bamber

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- 1) Response – 2 Pages
- 2) Petition for Extension of Time – Original + 1
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- 3)
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Comments:

Number of Pages Including this Page: 5

Inventor(s): Uchiyama, et al.

S.N.: 09/855,816

Filed: May 15, 2001

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